



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/161,283	09/28/1998	TOMOHIRO MAEKAWA	PMS255979	7428

7590

07/26/2002

FITCH, EVEN, TABIN & FLANNERY
120 SOUTH LaSalle STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

KRUER, KEVIN R

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 07/26/2002

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application N .

09/161,283

Applicant(s)

MAEKAWA, TOMOHIRO

Examiner

Kevin R Krueer

Art Unit

1773

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 July 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1, 2, 5 and 8-21.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: see attached

Advisory Action

Applicant's arguments filed July 22, 2002 have been fully considered but they are not persuasive. Furthermore, the proposed amendment will not be entered because (1) they raise new issues that would require further search and/or consideration, (2) they raise the issue of new matter, and (3) they are not deemed to place the application in better condition by materially reducing or simplifying the issues for appeal. The amendments would raise new issues because proposed claims 18 and 19 contain "parts by weight" ranges with respect to the rubber-containing polymer that have not been previously considered. Furthermore, the proposed "parts by weight" ranges of the rubber-containing polymer are not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed subject matter.

Applicant argues that Minghetti does not teach a 3-layered structure. The examiner never took the position that Minghetti disclosed a 3-layered structure. The examiner took the position that the single-layered structure taught in Minghetti was structurally identical to the claimed 3-layered structure when the 3 layers of the claimed structure each comprised the same composition. Since Applicant has not persuasively argued the structural difference between the claimed invention and the single-layered film taught in Minghetti, the examiner maintains the position.

Applicant also argues that the particles taught in Minghetti expand to over 200% of their original volume. However, Applicant never teaches that the claimed particles do not expand. Furthermore, the claims are not limited to particles that do not expand.

Art Unit: 1773

Thus, the examiner maintains the position that the particles taught in Minghetti read on Applicants claimed range since the particle size taught in Minghetti (100-2000um) overlaps Applicant's claimed range.

Applicant further argues that the composition taught in Minghetti and the laminate taught in Hatakeyama would not provide a molded article having effectively smaller bias of thickness in the secondary thermoforming. However, such a property is never claimed. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With respect to Minghetti in view of Hatakeyama, Applicant argues that Minghetti does not teach a 3-layered film. With respect to this argument, Applicant's attention is directed to the examiner's above comments. Applicant further argues that Hatakeyama does not teach a three-layered film or the presence of methyl methacrylate resin particles. The examiner points out that Hatakeyama was never relied upon for such teachings. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant also notes that the Office is on record as stating, "Hatakeyama does not teach that the base layer should comprise rubber containing


polymer." The Office is also on record as stating that Hatakeyama state neither that the resin layer contains rubber particles nor that the acrylic film layer A contains methyl methacrylate particles. However, the Office's comments are taken out of context. The Office's above-noted comments were pertinent to different rejections, not Minghetti in view of Hatakeyama. Thus, the examiner fails to see the relevance of such comments to the pending rejection based upon Minghetti in view of Hatakeyama.


With respect to Hatakeyama in view of Minghetti, Applicant argues that Hatakeyama does not teach a three-layered film. The examiner agrees, but maintains the position that it would have been obvious to one of ordinary skill in the art to laminate acrylic films on both sides of the resin layer given the expectation of equivalent results.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-0025. The examiner can normally be reached on Monday-Friday from 7:00a.m. to 4:00p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is 703-305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


KKR


Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700